



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,197	07/16/2001	Sami Nuutinen	P 282647	3048
909	7590	04/07/2004	2990210US/W/HER	
PILLSBURY WINTHROP, LLP			EXAMINER	
P.O. BOX 10500			TRINH, MINH N	
MCLEAN, VA 22102			ART UNIT	PAPER NUMBER
			3729	

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/905,197

Applicant(s)

NUUTINEN, SAMI

Examiner

Minh Trinh

Art Unit

3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 11-12 and 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following are examples.

a) It is not clear as to whether the limitation recites: "a circuit board of a plug in unit" is the same as "a circuit board " as previously cited in claim 10, line 2. Please clarify.

b) Regarding claims 18-19, the phrase "or the like" (i.e., see claim 18, line 2) renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

c) The phrase "the grip surface of the lifting element" (claim 20, lines 1-2) lacks proper antecedent basis.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10- 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al (US 5,307,041) in view of Kiesel et al (US 4,623,865). Kato et al teach the claimed electrical device (suppressor unit) of the present invention comprising: a holder 1 having a bottom surface adapted for holding the common mode choke for the noise suppressor of the power source module is arranged, a lifting element 1h (see Fig. 3B); a surface mounting element 2 (see Fig. 5A). Kato et al however do not teach the exact lifting element is a part of the holder and is being projected substantially from the middle of the top surface of the holder. Kiesel et al disclose a lifting element 22 having the configuration as described above (see Fig. 4, depicts the holder 23 having a projecting 22 at its center). Therefore, it would have been obvious to one ordinary skill in the art, at the time of the invention to have provided the invention of Kato et al with the teaching of a lifting member in light teachings Kiesel et al in order to form common holder structure having a desired lifting element which is a part of the holder and other elements associated therefrom. The motivation for this combination is discussed by Kiesel et al at col. 1, lines 37-40. Furthermore, regarding lifting element is a part of the holder as recited in the amended claim 1(see claim 1, lines 4-5). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a holder and a lifting element as a one piece structure, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

Art Unit: 3729

As applied to claim 11, Kato et al discloses the power source module being on a printed circuit board of a plug in unit as discussed at col. 4, lines 47-57);

As applied to claim 12, the limitation recites: "for an assembly head . . . for placing the noise suppressor unit onto the circuit board . . . " are intended use which do not further limit the claimed structure as presented in the claims (see preamble, line 1 of claims 10-20). Note that there is no structural difference between the claimed invention and the prior art reference. Therefore, the prior art structure is capable of performing the intended use.

As applied to claim 13, Kato et al disclose the bottom of the holder being substantially even as recited in claim 2 (see Figs. 1A and 3B).

As applied to claim 14, Kato et al disclose at least a mounting element such as pin being arranged in an opening of the holder as recited in claim 3 (see Fig. 3D pin 2 being arranged in the opening of the holder 1).

As applied to claims 15, 16 and 17, Kato et al disclose the at least one surface mounting element comprising a surface mounting foot as recited in claim 4 (see Fig. 3D, which shows the at least a surface mounting foot adapted to the associated power device); and the claimed subject matter as recited in claims 16 and 17 (see Fig. 3B-D which shows the at least one mounting foot 2B being partially embedded in the holder 1 and the bottom of the holder is substantially even and a mounting surface 2a being parallel to the holder).

Art Unit: 3729

Limitations of claims 18, 19 and 20 are also met by the prior art references (i.e., see Fig. 4 of Kiesel et al depicts that a lifting element 22 having a grip surface being substantially even, and that the holder and the lifting element are being parallel).

Response to Arguments

4. Applicant's arguments with respect to claims 11-20 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments regarding the cylindrical portion 22 could not be used as a lifting element. The examiner disagrees, for the following reasons, at first, the present claims do not require a lifting element having a closed top, and secondly, Kiesel's reference 22 as shown in Fig. 4 in combination with a coil 17 readable on the broadly claimed "a lifting element" of the present application claims. Further, Applicant's arguments have been carefully considered and are not persuasive. Specific claim language has not been referred to. The claims are broader than argued.

Interviews After Final

5. Applicant notes that an interview after a final rejection will not be granted unless the intended purpose and content of the interview is presented briefly, in writing (the agenda of the interview must be in writing). Such an interview may be granted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration. Interviews merely to restate arguments of record or

Art Unit: 3729

to discuss new limitations which would require more than nominal reconsideration or new search will be denied. See MPEP 714.13 and 713.09.

Prior Art References

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art references are cited for their teaching of electrical device or sensor unit i.e., inductor coil, transformer, or the like, etc.

Conclusion

7. Please provide numeral references to the claimed limitations as well as support in the disclosure (i.e., page and line numbers and reference number associated with from the drawings) for better clarity. Applicant requires pointing out the support for any amendment made to the disclosure and the claims. See 37CFR 1.111 and section 2163.06 of the MPEP.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 3729

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (703) 305-2887. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7307 for regular communications and (703) 305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.


Minh Trinh
Patent Examiner Group 3729

mt